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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,064	06/20/2001	Takehiro Yoshida	35.C15468	1689
5514	7590	10/04/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MENBERU, BENIYAM	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/884,064		YOSHIDA, TAKEHIRO	
	Examiner		Art Unit	
	Beniyam Menberu		2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25,29 and 33 is/are allowed.
- 6) ☒ Claim(s) 22-24,26-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Response to Arguments

1. Applicant's arguments filed June 13, 2005 have been fully considered but they are not persuasive. Kido discloses discriminating of effective image information for both sided documents. Yoshida et al disclose controller for determining of whether both-side or one-side transmission is to be used (column 40, lines 37-40; column 41, lines 25-51; column 42, lines 1-4) and indicates to the receiver a page number and information regarding front or reverse side (Figure 26; column 27, lines 20-43).

Oath/Declaration

2. The examiner acknowledges the stamped postcard. However the oath is not in the file. Examiner Williams did not receive the faxed copy of the oath. Applicant please submit a copy with response to be scanned into the file. The examiner apologizes for any inconvenience.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 22, 23, 24, 26, 27, 28, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-17877 to Kido in view of U.S. Patent No. 5815289 to Yoshida et al.

Regarding claims 22, 26, and 30, Kido discloses a facsimile apparatus, method, and program (page 11, lines 6-8) for reading images of original sheets in which both-side and one-side original sheets exist mixedly and transmitting them to a receiver station, comprising:

reading means for reading the images on both sides of the original sheet (page 7, lines 5-8);

means for discriminating whether the images on both sides read by said reading means have effective image information or not (page 7, lines 18-21). However Kido does not disclose control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means; and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when said both-side transmitting procedure is used, and omitting the transmission of said both-side transmission control information when said one-side transmitting procedure is used.

Yoshida et al disclose control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means (column 40, lines 37-40; column 41, lines 25-51; column 42, lines 1-4); and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, (column 27, lines 21-26) when said both-side transmitting procedure is used, (column 27, lines 21-26; column 24, lines 56-63) and omitting the transmission of said both-side transmission control information when said one-side transmitting procedure is used (In Figure 22A, when both side is not selected for transmission in step s672, steps s674, s676, s678, s680 follows wherein no information regarding page number or page information is sent.).

Kido and Yoshida et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the both side and one side facsimile information submission system of Yoshida et al with the facsimile system of Kido to implement effective transmission of mixed documents.

The motivation to combine the reference is clear because one-sided documents have only one page of information thus it is not necessary to send

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page information for such transmission but for both-side transmission Yoshida et al teaches that it is necessary to distinguish such transmission using the information that is received (column 49, lines 41-46).

Regarding claims 23, 27, and 31, Kido in view of Yoshida et al teach all the limitations of claims 22, 26, and 30 respectively. Further Yoshida et al disclose an apparatus, method, and program according to claim 22, wherein a count-up operation of said page number is executed only with respect to the both-side original sheet of which images on both sides have the effective image information (In figure 24 in step s750 and in figure 25, step s764, page counter is incremented for both sides transmission (Figure 22A, step 672)).

Regarding claims 24, 28, and 32, Kido in view of Yoshida et al teach all the limitations of claims 23, 27, and 31 respectively. Further Yoshida et al disclose an apparatus, method, and program, wherein the count-up operation of said page number is started after it is reset each time the both-side transmitting procedure is newly started (Figure 22a s668, s672 ("Yes"), Figure 22b s686, s688, Figure 23 s710, s712; column 25, lines 1-14, lines 25-30, lines 64-67; column 26, lines 1-2).

Allowable Subject Matter

5. Claims 25, 29, and 33 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

In addition to the teachings of the claims 25, 29, and 33 as a whole, the closest prior art of record failed to teach or suggest: "transmitting to the receiver station a value to be allocated to the front side when it is assumed that the one-side original sheet is the both-side original sheet, as a page number of the one-side original sheet, in case said one-side transmitting procedure is used".

Other Prior Art Cited

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5408340 to Edamura disclose method for facsimile transmission control.

U.S. Patent No. 5559721 to Ishii disclose multi-media information transfer system.

U.S. Patent No. 6353717 to Suzuki disclose recording apparatus.

U.S. Patent No. 6148164 to Shima disclose printer with double side printing function (see Figure 14; column 17).

U.S. Patent Application Publication No. US 2004/0125394 A1 to Terao et al disclose image forming apparatus (paragraph 30, 122).

U.S. Patent No. 6687742 to Iwazaki disclose communication control method.

JP409214681A to Takaoka disclose image reader.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone

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number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.


For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

09/28/2005


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER